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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/614,584	07/07/2003	Frank Gordon Krausz	10547.26US2	7595
34018	7590	11/30/2005	EXAMINER	
GREENBERG TRAUIG, LLP 77 WEST WACKER DRIVE SUITE 2500 CHICAGO, IL 60601-1732			HUYNH, CONG LAC T	
			ART UNIT	PAPER NUMBER
			2178	

DATE MAILED: 11/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/614,584

Applicant(s)

KRAUSZ ET AL.

Examiner

Cong-Lac Huynh

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 July 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>10/6/03 &amp; 2/2/04</u> . | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This action is responsive to communications: the application filed on 7/7/03, priority filed 7/10/02.
2. Claims 1-22 are pending in the case. Claims 1, 14, and 20 are independent claims.

#### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 1-16, 18, 20-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Suehira (US Pat No. 6,922,697 B1, 7/26/05, filed 11/16/99) in view of Mason (US Pat App Pub No 2001/0051918 A1, 12/13/01, filed 3/14/01, priority 3/14/00).

Regarding independent claim 1, Suehira discloses:

- generating the layout and the data such as characters or pictures of a SGML document by developing the tags defined by a document type definition DTD (col 1, line 17 to col 2, line 57, col 5, line 29 to col 6, line 22)

Suehira does not disclose that the tags are the IML tags and the document to be generated is an invoice.

Mason discloses generating an HTML invoice ([0027], [0030]).

It would have been obvious to an ordinary skill at the time of the invention was made to have combined Mason into Suehira for the following reason. Mason discloses generating an HTML invoice which implies that HTML tags are used to generate an invoice, where the HTML can be replaced by IML, a markup language for invoices. Mason, thus, provides the advantage to incorporate into Suehira for effectively generating the layout and data for an invoice using sets of markup tags defined by a document type definition as desired.

Regarding claims 2 and 3, which are dependent on claims 1 and 2 respectively, Suehira does not disclose that the first set of IML tags comprises a filter or a grouping filter.

Mason discloses a flag is raised for a customer in the stored invoice if the total balance meets some predetermined criteria or a flagged invoice indicating that the payment is not available ([0032]).

It would have been obvious to an ordinary skill at the time of the invention was made to have combined Mason into Suehira since the flag in the invoice in Mason suggests that

there be the HTML *tags for the flag to filter the required data for the invoice*. This motivates to use different markup tags, the IML tags, for the same flag for the invoice. It also motivates to incorporate into Suehira for using IML tags comprising a filter or a grouping filter for presenting data particularly required in an invoice document.

Regarding claim 4, which is dependent on claim 3, Suehira does not disclose that the first set of IML tags comprises an accumulator.

Mason discloses the HTML invoice with the total charge and total amount due (figure 4a). This implies that there is the HTML tags to define an accumulator for such amounts.

It would have been obvious to an ordinary skill at the time of the invention was made to have combined Mason into Suehira for the following reason. Mason discloses HTML tags for defining an accumulator in an invoice thus motivating to use different markup language, the IML, for defining an accumulator in an invoice, and motivating to incorporate into Suehira for effectively generating an accumulator, a necessary tool for presenting the total amounts in an invoice.

Regarding claim 5, which is dependent on claim 1, Suehira does not disclose that the first set of IML tags comprises an expression.

Mason discloses presenting an on-line invoice including the amount of the discount data and the discount availability period ([0029]).

It would have been obvious to an ordinary skill at the time of the invention was made to have combined Mason into Suehira for the following reason. The discount data and the discount availability period Mason suggests that an expression be included in the markup tags for describing such data. This motivates to use different markup language tags, the IML tags, comprising the same expression for presenting the discount data in the invoice document.

Regarding claim 6, which is dependent on claim 1, Suehira does not disclose that the second set of IML tags comprises a field.

Mason discloses the HTML invoice includes fields for populating data ([0036]).

It would have been obvious to an ordinary skill at the time of the invention was made to have combined Mason into Suehira for the following reason. Mason discloses HTML tags for defining fields for populating data in an invoice thus motivating to use different markup language, the IML, for defining the same fields in an invoice, and motivating to incorporate into Suehira for having IML markup tags to define the fields for an invoice document.

Regarding claim 7, which is dependent on claim 1, Suehira discloses that the second set of IML tags comprises a grid.

Mason discloses an on-line invoice ([0030]).

It would have been obvious to an ordinary skill at the time of the invention was made to have combined Mason into Suehira since the on-line invoice in Mason suggests that the

grid in the invoice be displayed and there exist markup tags for defining said grid. This motivates to use different markup language tags, the IML tags, for defining the same grid for an invoice.

Regarding claim 8, which is dependent on claim 1, Suehira discloses that the second set of IML tags comprises an aggregate.

Mason discloses the HTML invoice with the total charge and total amount due (figure 4(a)). This implies that there is the HTML tag to define an aggregate for such amounts. It would have been obvious to an ordinary skill at the time of the invention was made to have combined Mason into Suehira for the following reason. Mason discloses HTML tags for defining an aggregate in an invoice thus motivating to use markup language IML for defining an aggregate in an invoice, and motivating to incorporate into Suehira for effectively generating an aggregate, a necessary tool for presenting the amount in an invoice.

Regarding claim 9, which is dependent on claim 1, Suehira discloses that the second set of IML tags comprises a segment.

Instead, Suehira discloses the SGML tags comprises a segment (col 1, lines 17-47, col 5, lines 29-52: the fact that the SGML document is a structured document defined by SGML tags implies that said structured document includes segments implemented by SGML tags).

Therefore, it would have been obvious to an ordinary skill at the time of the invention was made to have modified Suehira to use the IML tags for a segment in structured document instead of the SGML tags since both SGML and IML are markup languages for implementing a structured documents.

Regarding claim 10, which is dependent on claim 1, Suehira discloses that the second set of IML tags comprises a layout.

Instead, Suehira discloses SGML tags for the layout of the structured document (col 5, lines 29-52, col 6, lines 15-22).

It would have been obvious to an ordinary skill at the time of the invention was made to have modified Suehira to use the IML tags for the layout of the structured document instead of the SGML tags since both SGML and IML are markup languages for implementing a structured documents.

Regarding claim 11, which is dependent on claim 1, Suehira does not disclose that the second set of IML tags comprises a header.

Mason discloses a HTML invoice ([0027], [0030]) where it was well known that any HTML document has a title, which is equivalent to a header, defined by title tags.

Therefore, it would have been obvious to an ordinary skill at the time of the invention was made to have combined Mason into Suehira for the following reason. The HTML invoice with title tags in Mason motivates to apply a different markup language such as



the IML for a same title since both IML and HTML are markup languages for generating an invoice.

Regarding claim 12, which is dependent on claim 1, Suehira discloses that the second set of IML tags comprises a footer.

Mason discloses an on-line HTML invoice ([0027], [0030]) where it was well known that a HTML document has a portion at the end of the document, which is equivalent to a footer, for contact information or copyright, defined by corresponding tags.

Therefore, it would have been obvious to an ordinary skill at the time of the invention was made to have combined Mason into Suehira for the following reason. The HTML invoice with HTML tags in Mason motivates to apply a different markup language such as the IML for a same footer since both IML and HTML are markup languages for generating an invoice.

Regarding claim 13, which is dependent on claim 1, Suehira does not disclose that the second set of IML tags comprises a delimiter.

Mason discloses a HTML invoice ([0027], [0030]). This implies that HTML tags with opening and closing tags, which are equivalent to a delimiter, are used for implementing an invoice.

Therefore, it would have been obvious to an ordinary skill at the time of the invention was made to have combined Mason into Suehira since the HTML invoice with HTML tags in Mason motivates to apply a different markup language such as the IML with tags

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for a delimiter since both IML and HTML are markup languages for generating an invoice.

Regarding independent claim 14, Suehira discloses:

- generating the layout and the data such as characters or pictures of a SGML document by developing the tags defined by a document type definition DTD (col 1, line 17 to col 2, line 57, col 5, line 29 to col 6, line 22)

Suehira does not disclose that the tags are the IML tags and the document to be generated is an invoice.

Mason discloses generating an HTML invoice ([0027], [0030]).

Mason further discloses:

- providing the IML file to an invoice generating application which accesses a database of a service provider to collect data according to the first set of tags and which uses the collected data and the second set of tags to generate an invoice output file ([0011]-[0013]: retrieving information from a database corresponding to a customer to generate an invoice shows accessing the database for retrieving data)
- providing the invoice output file to an output device which uses the invoice output to generate the invoice ([0027], 0030])

It would have been obvious to an ordinary skill at the time of the invention was made to have combined Mason into Suehira for the following reason. Mason discloses generating an HTML invoice which implies that HTML tags are used to generate an

invoice, where the HTML can be replaced by IML, a markup language for invoices.

Mason, thus, provides the advantage to incorporate into Suehira for effectively specifying a layout and selecting data for including in an invoice via sets of markup tags defined by a document type definition as desired.

Regarding claim 15, which is dependent on claim 14, Suehira does not disclose that the invoice output file comprises an HTML file.

Mason discloses that the invoice output file comprises an HTML file ([0027], [0030]).

It would have been obvious to an ordinary skill at the time of the invention was made to have combined Mason into Suehira since Mason discloses generating an HTML invoice, which implies that HTML tags are used in said generating, providing the advantage to incorporate into Suehira for obtaining an HTML file as an invoice output file.

Regarding claim 16, which is dependent on claim 15, Suehira does not disclose transmitting the output file via a network to the output device.

Mason discloses the on-line HTML invoice ([0027], [0030]). The on-line invoice shows that transmitting the output invoice via a network to an output device of a client.

It would have been obvious to an ordinary skill at the time of the invention was made to have combined Mason into Suehira for further transmitting a markup invoice document over the network to a client output device.

Regarding claim 18, which is dependent on claim 16, Suehira discloses that the output device comprises a personal computer (figure 2, col 4, lines 56-64).

Claims 20-21 are for a system for performing method claims 14 and 15, and are rejected under the same rationale.

6. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Suehira in view of Mason as applied in claim 16 above, and further in view of Emmett et al. (US Pat App Pub No 2002/0129006 A1, 9/12/02, filed 2/14/02, priority 2/16/01).

Regarding claim 17, which is dependent on claim 16, Suehira and Mason do not disclose that the output device comprises a hand-held processing device. Suehira discloses that the output device is a personal computer (col 4, lines 56-64).

Emmett discloses that handheld devices including Personal Digital Assistants (PDAs) and cellular telephones offer connectivity to the Internet and permit access to documents available over the Internet ([0005]).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have combined Emmett into Suehira and Mason since Emmett discloses that a handheld device can access to a document available on the Internet providing the advantage to incorporate into Suehira and Mason for having a handheld device as a convenient output device, since a user can carry it with him or her anywhere, for accessing an online invoice, a form of Internet document.

7. Claims 19 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Suehira in view of Mason as applied in claim 16 above, and further in view of Scolini et al. (US Pat App Pub No 2003/0233321 A1, 12/18/03, filed 10/30/02, priority 11/30/01).

Regarding claim 19, which is dependent on claim 14, Suehira and Mason do not disclose that the invoice output file comprises a printer-control language file.

Scolini discloses that the invoice or customer bill is converted into AFP format as the output file ([0842], [0980]).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have combined Scolini into Suehira and Mason since the AFP form, which is a printer-control language file, of the invoice in Scolini provides the advantage to incorporate into the invoice in Suehira and Mason for rapidly printing the invoice document at a printer site.

Claim 22 is for a system for performing method claim 19, and is rejected under the same rationale.

### ***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Maurya et al. (US Pat No. 6,751,452).

Alexander (US Pat No. 6,732,331).

Virgin et al. (US Pat No. 6,826,542).

Hanagan et al. (US Pat App Pub No. 2001/0056362 A1).

Sijacic et al. (US Pat App Pub No. 2002/0184145).

Lam et al. (US Pat App Pub No. 2003/0220855).

Bennett et al. (US Pat App Pub No. 2002/0116334).

Thomas et al. (US Pat App Pub No. 2005/0108153).

James et al. (US Pat App Pub No. 2004/0205694).

Pokony, Modelling Stars Using XML, ACM 2001, pages 24-31.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cong-Lac Huynh whose telephone number is 571-272-4125. The examiner can normally be reached on Mon-Fri (8:30-6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong can be reached on 571-272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Cong-Lac Huynh  
Primary Examiner  
Art Unit 2178  
11/23/05